

Remarks/Arguments:

Amendments

Support for newly presented claims 32-42 is found in original claims 3-13, respectively. It is submitted that no new matter is introduced by these new claims.

Rejection under 34 USC 103(a)

Claims 1-31 were rejected as unpatentable over "Van Damme." Two Van Damme patents have been cited. However, Van Damme, U.S. Patent No. 6,140,005 ("Van Damme"), appears to be the patent of interest. To clarify the record, the Examiner is respectfully requested to confirm this in the next communication.

1. Claims 1-31 and New Claims 32-42

The instant application contains claims drawn to (1) an imageable element, (2) a method for forming an imageable element, and (3) a method for forming an image. Van Damme will be discussed with respect to the rejection of all the claims, and then the rejection of specific groups of claims will be addressed.

Van Damme discloses an imageable element comprising, in order:

a support;

a photosensitive layer; and

a thermosensitive layer that is

opaque to light for which the photosensitive layer has spectral sensitivity;

capable of being rendered transparent by exposure to laser light; and

soluble or swellable in an aqueous medium.

Van Damme, Abstract and Claim 1.

The Office equates the thermosensitive layer of Van Damme with the top layer recited in applicants' claims, and the photosensitive layer of Van Damme with the underlayer recited in applicants' claims. Paper 5, page 2, lines 20-24.

The Office relies on the following passage from Van Damme:

A thermosensitive layer in connection with the present invention may further be cross-linked to make the imaging element less prone to damage caused during handling of the imaging element.

Van Damme, column 3, lines 26-29.

Van Damme suggests that the top layer may be crosslinked. However, Van Damme provides no further suggestion or indication as to how this might be accomplished. The Office correctly points out that Van Damme fails to disclose a crosslinked top layer in an example. Paper 5, page 2, line 25. As is well known to those skilled in the art, crosslinked polymers are insoluble in commonly used coating solvents and, thus, can not be coated from these solvents. Further, a crosslinked top layer would be difficult to use in Van Damme's invention because the top layer is removed in the final step of his method. See, Van Damme, claim 12.

The passage relied on by the Office is a suggestion for further research. The person of ordinary skill in the art, having the advantage of the teachings of Van Damme, would not know how to proceed to produce an imageable element with a crosslinked top layer.

Further, the top layer of applicants' imageable element is ink receptive and insoluble in an alkaline developer but removable by an alkaline developer in the exposed regions, but not in the unexposed regions, following thermal exposure of the element. Claims 1 and 30. In contrast, Van Damme's top layer is removable by the developer. Van Damme, claim 12. The person of ordinary skill in the art, having the advantage of the teachings of Van Damme, would not know there was a high probability of success that an imageable element with a crosslinked top layer that would have the properties necessary for image formation could be produced.

At best, Van Damme rises to the level of "obvious to try." However, the Federal Circuit has held that "obvious to try" is not the same as obviousness under 35 U.S.C. 103(a). *Gillette Co. v. S.C. Johnson & Sons, Inc.*, 16 USPQ2d 1923, 1928 (Fed. Cir. 1990) (citing references).

Thus, the Office has not made the *prima facie* case. The rejection of claims 1-31 as unpatentable over Van Damme should be withdrawn.

2. *Claims 8-15, drawn to an Imageable Element*

Claim 8 introduces the additional limitation that the top layer is substantially free of the photothermal conversion material. In this imageable element, the infrared imaging radiation passes through the top layer and is absorbed either by the underlayer or by a separate absorber layer. The top layer does not absorb any substantial amount of the imaging radiation. See, specification, page 14, line 28, to page 15, line 1.

This limitation is neither disclosed or suggested by Van Damme. In Van Damme, the top (thermosensitive) layer contains the infrared absorber (infrared pigment) and, thus, absorbs the infrared radiation. See, Van Damme, column 2, line 66, to column 3, line 1. Van Damme describes the top layer an "IR-sensitive Coating." See, Van Damme, column 12, lines 51-54. Nothing Van Damme suggests a top layer that is substantially free of the photothermal conversion material.

Because, this limitation is missing from Van Damme, the Office has not made the *prima facie* case. For this additional reason, the rejection of claims 8-15 as unpatentable over Van Damme should be withdrawn.

3. *Claims 16-29, drawn to a Method for Forming an Imageable Element*

Claims 16-29 are drawn to a method for forming an imageable element in which the top layer comprises a crosslinked polymer.

As discussed above, Van Damme does not disclose or suggest any method for preparing an imageable element in which the top layer comprises a crosslinked polymer.

Because Van Damme does not disclose or suggest any method for preparing an imageable element in which the top layer is crosslinked, the Office has not made the *prima facie* case. For this additional reason, the rejection of claims 16-29 as unpatentable over Van Damme should be withdrawn.

4. *Claims 30-31 and New Claims 32-42, drawn to a Method for Forming an Image*

Claims 30-31 and new claims 32-42 are drawn to method for forming an image.

Van Damme's method comprises three steps, as follows:

(1) image-wise exposing an imaging element as defined in claim 1 by means of a laser thereby imagewise rendering said thermosensitive layer transparent to light for which said photosensitive layer has spectral sensitivity;

(2) overall exposing a thus obtained imaging element with light for which said photosensitive layer has spectral sensitivity;

(3) developing a thus obtained imaging element thereby removing said thermosensitive layer and either the non-exposed or the exposed areas of said photosensitive layer so as to leave an ink accepting image of said photosensitive layer on said support.

Van Damme, claim 12.

In effect, Van Damme's top layer is an integral photomask, which is imaged with infrared radiation. Overall exposure is carried out using the imaged top layer as a photomask, and top layer is completely removed in the developing step.

Applicants' method is different. In applicants' method, after the element is imaged with infrared radiation, both the top layer and the underlayer are removed by the developer in the imaged regions only. Nothing in Van Damme discloses or suggests this method. Nothing in Van Damme discloses or suggests how an imageable element in which a crosslinked top layer that is removable by a developer in the imaged regions following thermal imaging could be prepared.

The Office has not made the *prima facie* case. Van Damme does not disclose or suggest applicants' method. For this additional reason the rejection of claims 30-31 as unpatentable over Van Damme should be withdrawn. It is submitted that new claims 32-42 are allowable as claims dependent on an allowed claim.

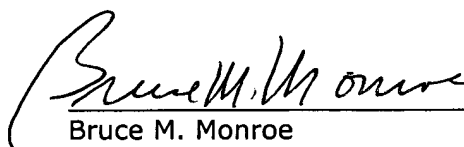
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KPG-5041US

Conclusion

It is respectfully submitted that the claims are in condition for immediate allowance and a notice to this effect is earnestly solicited. The Examiner is invited to phone applicants' attorney if it is believed that a telephonic or personal interview would expedite prosecution of the application.

Respectfully submitted,



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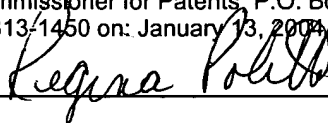
Enclosures:

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